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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,694	12/02/2004	Robert Mostowski	849-007	5302
39600	7590	01/10/2006		
SOFER & HAROUN LLP. 317 MADISON AVENUE, SUITE 910 NEW YORK, NY 10017			EXAMINER BALDWIN, GORDON	
			ART UNIT	PAPER NUMBER
			1775	
DATE MAILED: 01/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/516,694

Applicant(s)

MOSTOWSKI, ROBERT

Examiner

Gordon R. Baldwin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Consider claim 1, the use of “in particular” is considered vague terminology due to the claim language first claiming a blown glass ornament and then claiming a “Christmas tree or other seasonal ornament” which is considered a narrower limitation of a “blown glass ornament” in the same claim.

Consider claim 6, the use of “bending aside” is considered vague and indefinite since no direction or structurally defining of the movement is given to indicate the nature of the movement of “bending aside.”

Consider claim 8, in the third line, “any one of a lace, or a hanger, an ornamental string, a bow and a wire.” is an improper Markush group and therefore considered vague and indefinite.

Consider claim 9, in the second line, “having any one of a shell construction or a closed, solid, is provided with a flat surface.” is an improper Markush group and is therefore considered vague and indefinite.

Consider claim 11, in the forth line, "any one of paint, glitter, gold, silver and engraving." is an improper Markush group and therefore considered vague and indefinite.

Double Patenting

Provisional Statutory Double Patenting:

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1,2,4,7 and 11 of Application No. 10/516694 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of **claims 1,4,6,9 and 12 of copending Application No. 11009960 respectively**. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Provisional Obviousness Double Patenting:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

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and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3, [5 and 8], 6, and 10 of Application No. 10/516694 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 5,7,8 and 10 respectively of copending Application No. 11009960**. Although the conflicting claims are not identical, they are not patentably distinct from each other because while '694 does not correspond word for word to the claims of '960, it would have been obvious to one of ordinary skill in the art at the time of invention that the subject matter is an obvious variant. Specifically, joints and hinges are obvious variants for forms of attachment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Pat. No. 4,224,364 (Hunt).

Consider claim 1, Hunt teaches a glass ornament (Col. 4 lines 3-5) with two different modules or housing sections (11) and (12) that can be hollow, shell-like or any shape (Col. 1, lines 60-66) and are connected by a connector ring (13), which form a plane between both housing sections in figure (9). (Col. 3 lines 62-67 and Col. 4 lines 1-2) Additionally, “blown” is considered a process limitation and does not distinguish over the structure of the prior art.

Consider claim 2, Hunt teaches that both housing sections (11 & 12) are to be frictionally fit against the flanges of the ring (13), and are to be releasably retained. Since both housing sections are secured on the rim, the rim is considered to have two locks, that makes one lock on either side of the ring (13) which retain both housing sections. (Col. 2 lines 19-23)

Consider claim 10, Hunt teaches that items may be placed inside the ornament. (Col. 2 lines 40-44)

Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Pat. No. 1,956,161 (Smith)

Consider claim 1, Smith teaches the making of solid blown glass decoration in the shape of a canteen globe (Col. 1 lines 1-4) or roughly shell-like that is separated into two shell-like sections with a joint (fig. 12) securing the two sections together.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,4, 5,6,7,8,9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pat. No. 1,956,161 (Smith) in view of <http://www.faberge.de/relaunch/index.html> (The Elephant Egg).

Consider claim 3, Smith teaches claim 1, but Smith does not teach that the first and second modules are connected by an articulating joint and are closed by one lock on the rim of each module. Faberge(<http://www.faberge.de/relaunch/index.html>) teaches the use of the first module having an articulating joint to connect the two modules with a lock as a closing means on the top part of the rib of the module. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the glass modules of Smith with the articulating joints and locks of Faberge to

be able to have access to the inner portion of the modules to have a greater area to decorate the modules.

Conversely, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the Faberge Elephant Egg out of glass, as Smith clearly teaches that it is known to form a globe with multiple pieces made of blown glass which are hinged together and are provided with etching and/or paint for decoration thereof.

Consider claim 4, Smith teaches that the globe is initially formed of one piece with specific structural faults that allow the two portions (first module and second module) to be separated by breaking the glass in the designed weak points. (Col. 1, lines 38-50)

Consider claim 5, Faberge, specifically with the Elephant Egg, teaches that the top module of the egg has two body portions that are joined to the lower module with the use of a articulated hinge with the two upper bodies being able to clasp together through the use of a latch and place the two "spatial" bodies and the lower module on a common plane.

Consider claim 6, Faberge teaches the use of gold for the metal in its rims along with the articulating joints for connecting the modules.

Consider claim 7, Faberge teaches a projection that can be used for suspending a hanger.

Consider claim 8, Faberge teaches the spatial bodies as stated in the rejection of claim five (5) along with a projection in the top part of the body which can have a variety of items affixed to it, including lace or a lace hanger.

Consider claim 9, Faberge teaches the use of a second bottom module in the oval shape of an egg, constituting a shell construction, with a flat surface upon which an ornament or decoration is placed.

Consider claim 11, Faberge teaches that the outer surface of the ornament is treated with enamel and white opals and jewels. Additionally, "obtained from a metal mould" is considered a process limitation and does not distinguish over the structure of the prior art.

Consider claim 12, Faberge teaches a roof in which a miniature object is placed inside the modules.

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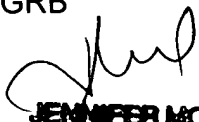
Conclusion:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon R. Baldwin whose telephone number is (571)272-5166. The examiner can normally be reached on M-F 7:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah D. Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GRB


JENNIFER MCNEIL
PRIMARY EXAMINER
1/6/06